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IN THE HIGH COURT OF DELHI AT NEW DELHI

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CS (OS) 458/2015

SHOPPERS STOP LTD.

..... Plaintiff

Through: Mr. Sagar Chandra & Mr. Ankit
Rastogi & Ms. Srijan Uppal,
Advocates.

versus

VINOD'S SHOPPERS STOP

..... Defendants

Through: None.

CORAM: JUSTICE S. MURALIDHAR

ORDER

19.09.2016

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1. The prayer in this suit by Shoppers Stop Limited (the Plaintiff) is *inter alia* for a decree of permanent injunction to restrain Vinod's Shoppers Stop (the Defendant) from infringing the Plaintiff's registered trademark, and for passing off, delivery up, rendition of accounts, damages etc.

2. Summons in the suit and notice in the applications were issued on 23rd February, 2015. On that date an ad interim *ex parte* order was passed restraining the Defendant "from using the trade name and trademark 'Shoppers Stop' or any other deceptively trademark which amounts to infringement of the trademark of the Plaintiff and passing of his goods as that of the Plaintiff."

3. Subsequently, on 4th November, 2015, this Court passed the following order:

"1. The suit has been placed before the Court by the Joint Registrar, who has recorded In the order dated 12.10.2015 that the defendant has not filed the written

statement. Further, none was present on behalf of the defendant on the said date.

2. Counsel for the plaintiff states that the defendant had entered appearance through counsel on 03.08.2015 and on the said date, at the request of the counsel for the defendant, the parties were referred to mediation. However, the defendant's counsel had appeared only on one date. i.e., on 17.08.2015, the date fixed by this Court. Thereafter, the defendant and the counsel did not appear before the learned Mediator. Notice of default was also issued by the Mediation Centre to the defendant for appearance but they did not appear. The position remains the same today. Accordingly, the defendant is proceeded against ex-parte.

3. The plaintiff is directed to file the affidavit by way of evidence within eight weeks.

4. List before the Joint Registrar on 28th January, 2016 for tendering the evidence.

5. The dates already fixed, i.e., 07.11.2015 and 28.01.2016 stand cancelled.

I.A. 3587/2015 (bv the plaintiff u/o XXXIX R 1 and 2 CPC)

1. The present application has remained unopposed. As noted above, the defendant and its counsel have stopped appearing in the case. It appears that the defendant does not wish to oppose the present application, which is accordingly allowed. The interim order dated 23.02.2015 is made absolute.

2. The application is disposed of."

4. Pursuant to the above order, the Plaintiff filed an affidavit of *ex parte* evidence of Mr. Navdeep Chaudhary on 8th July, 2016.

5. The uncontroverted facts emerging from Mr. Navdeep Chaudhary's

affidavit are as under:

(i) The Plaintiff was established in the year 1997 under the name & style of 'Shoppers Stop Ltd.' and has been continuously and uninterruptedly using the name 'SHOPPERS STOP' since that day as a trade name and trade mark.

(ii) The mark 'SHOPPERS' STOP' was first adopted in 1991 by the Plaintiff's predecessor in interest, Ivory Properties & Hotels Ltd., hereinafter referred to as 'IPHL'. The said use was in relation to retailing services to be rendered through large format departmental stores/shopping centers/malls for the sale of various goods. 'IPHL' accordingly commenced use of the mark 'SHOPPERS' STOP' and started operations with the first store located in suburban Mumbai, Andheri.

(iii) Initially, the business was used to be run in the name of 'SHOPPERS' STOP', which was a Division of 'IPHL'. Later, by virtue of assignment deed dated 31st March, 2000 with effect from 1997, 'IPHL' assigned absolutely and forever all its rights, title and interest in the trade mark 'SHOPPERS' STOP', *inter alia*, along with its goodwill in favour of the Plaintiff. The Plaintiff has thus been using the mark 'SHOPPERS STOP' uninterruptedly till date. In or around the year 2007, the Plaintiff dropped the apostrophe (') from the mark 'SHOPPERS' STOP' and has, thereafter, continuously and in an uninterrupted manner used the mark 'SHOPPERS STOP' upon and in relation to its retailing services.

(iv) The Plaintiff carries its business under various brands such as HomeStop, Crossword, HyperCity etc. The most prominent is the multi-brand departmental store retail business by the name of 'SHOPPERS STOP'.

(v) Presently, the Plaintiff has 81 stores across 38 cities including the prominent cities of Delhi, Mumbai, Kolkata, Chennai, Bangalore, Hyderabad, Ahmedabad, Pune, Jaipur, Noida, Agra and Gurgaon. The trademark 'SHOPPERS STOP' of the Plaintiff has been registered in almost all classes for the territory of India and Plaintiff also has foreign registrations in the territory of USA, UAE and the European Union. Moreover, the Plaintiffs loyalty programme which is the First Retail Loyalty Programme called the First Citizens Club crossed the 2.8 million mark in 2012-2013 and is one of the largest loyalty programme across sectors.

(vi) The Plaintiff's sales revenue in 2012-2013 was Rs. 2560 crores. The Plaintiff has an e-commerce website bearing the domain name www.shoppersstop.com under which it delivers to more than 1200 cities and towns across the country. A print out of the annual Reports of the Plaintiff of various years since 2003-2004 till 2015-16, except for the year 2004-2005 as available on the website of the Plaintiff shows the extensive use of the mark 'SHOPPERS STOP' by the Plaintiff.

6. The case of the Plaintiff which has not been countered by the Defendant is that

(a) 'SHOPPERS STOP' is a common household name in India which is known for its superior quality of products, services and above all, for providing a complete shopping experience. It provides a broad range of branded and in-house label apparels, footwear, perfumes, cosmetics, jewelry, leather products and accessories, home products, books, music and toys etc.

(b) The mark 'SHOPPERS STOP' is being extensively used by the Plaintiff pan India. The mark 'SHOPPERS STOP' has a nationwide presence and cuts through all age groups.

(c) By virtue of prior adoption, such long, continuous and uninterrupted use and extensive promotion, the trademark 'SHOPPERS STOP' as well as various other marks of the Plaintiff which incorporate the mark 'SHOPPERS STOP' have come to be associated with the Plaintiff in respect of retail outlets and departmental stores and has thus acquired the status of a well-known trademark.

(d) The mark 'SHOPPERS STOP' has been extensively covered by the media as well. The Plaintiff also provides multiple advertisements on print media, including but not limited to Delhi Times and Times Nation.

7. The Plaintiff states that in the month of January, 2015 it learnt that the Defendant operates a retail outlet bearing a deceptively similar mark 'VINOD'S SHOPPERS STOP'. This led to the filing of the present suit. The report (Ex. PW - 1/22) of the Local Commissioner (LC) appointed by the Court by order dated 23rd February 2015 to search the premises of the Defendant revealed that the Defendant was using the mark 'VINOD'S SHOPPERS STOP' on carry bags, bill books, rubber stamp, visiting cards, purchase bills, cheque books and hoardings. The element of confusion was apparent in the instance of one purchase bill found in the Defendant's premises where a third party Route 77 Trade Culture, referred to the Defendant as Shoppers Stop. The LC's report also showed that the Defendant has been carrying on a substantial business under the mark 'VINOD'S SHOPPERS STOP'. The LC's Inventory Report showed that

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there were copies of 804 invoices of sales made by the Defendant. Other than that two more used bill books of 100 invoices each were with Defendant's chartered accountant.

8. There is merit in the Plaintiff's case that the use of the trade mark 'VINOD'S SHOPPERS STOP' by the Defendant indicates to the consumer that the Defendant is associated with the Plaintiff or that there is a trade connection between them. The chances of the confusion are enhanced by the fact that both the parties are in the business of operating retail outlets that deal with fashion apparels. The Defendant is thus trying to exploit the reputation and goodwill of the Plaintiff in order to reap profits and gain unlawful advantage. This also constitutes a dilution of the Plaintiff's trade mark in addition to infringement of trademark, trade name and passing off of the goods of the Defendant as those of the Plaintiff. The Plaintiff and the Defendant are undertaking the same activity, i.e., multi-brand retail outlets. The class of consumers of the goods and services of the Plaintiff and the Defendant are also identical.

9. The Plaintiff has been able to show that its mark Shoppers Stop has attained the status of a well known mark as defined under Section 2 (zg) of the Trade Marks Act 1999 i.e. "a mark which has become so to the substantial segment of the public which uses such goods or receives such services that the use of such mark in relation to other goods or service would be likely to be taken as indicating a connection in the course of trade or rendering of services between those goods or services and a person using the mark in relation to the first-mentioned goods or services." It accordingly deserves a higher degree of protection as explained in ***Ford Motor Company v. C R Borman 2014 (59) PTC 132.***

10. In the result the Court issues

(i) a decree of permanent injunction restraining the Defendant, its directors, executives, partners or proprietors, as the case may be, its officers, servants and agents or anyone acting for and on their behalf from operating, marketing, offering for sale, advertising or in any manner dealing in any goods and/or services including but not limited to "Retail outlets/e-commerce portals selling apparels, footwear, perfumes, cosmetics, jewellery, leather products and accessories, home products, books, music, toys, etc." under the mark 'VINOD'S SHOPPERS STOP' and/or from adopting any other mark which is identical or deceptively similar to the Plaintiffs trade mark 'SHOPPERS STOP' and various other marks of the Plaintiff which incorporate the trade mark 'SHOPPERS STOP' amounting to passing off or doing any other thing which will lead to passing off of the goods and services of the Defendant as those of the Plaintiff, or which would amount to infringement of the Plaintiffs registered trademarks, or from doing any other act amounting to dilution of goodwill and reputation of the Plaintiff's trademark 'SHOPPERS STOP'.

(ii) a Decree against the Defendant, its directors, executives, partners or proprietors, as the case may be, its officers, servants and agents or anyone acting for and on their behalf for delivery up of all the products, goods, labels, cartons, brochures, advertising material and/or any other document/written material bearing the mark 'VINOD'S SHOPPERS STOP' or any other mark the use of which may amount to passing off or infringement of trademarks of the Plaintiff to the authorized representative of the Plaintiff for the purpose of destruction/erasure;

(iii) a decree for rendition of accounts of profits illegally earned by the Defendant on account of the sale of the products or providing of services bearing the marks which are identical and/or deceptively similar to the Plaintiffs trademark 'SHOPPERS STOP', and various other marks of the Plaintiff which incorporate the trade mark 'SHOPPERS STOP' and a decree for the amount so found due be passed in favour of the Plaintiff;

11. The Defendant shall pay the Plaintiff Rs. 1 lakh towards costs of this suit. The decree sheet be drawn up in the above terms.

S. MURALIDHAR, J

SEPTEMBER 19, 2016